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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,086	12/21/2001	Robert E. Denman	22171.299	1095
27683 7590 11/06/2009 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER				
PHILLIPS, HASSAN A				
ART UNIT		PAPER NUMBER		
2451				
MAIL DATE		DELIVERY MODE		
11/06/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. DENMAN, SRIRAM PARAMESWAR, and
BARBARA DERRYBERRY

Appeal 2008-004962
Application 10/028,086
Technology Center 2400

Decided: November 6, 2009

Before HOWARD B. BLANKENSHIP, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-16 and 18-36. Claim 17 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We AFFIRM-IN-PART.

STATEMENT OF THE CASE

According to Appellants, the invention relates to a method and apparatus for half-duplex communication among multiple telecommunications devices via a packet data network. (Spec. [0001]).

Exemplary Claims

1. A wireless communication network including push-to-talk (PTT) functionality, comprising:
 - a Session Initiation Protocol (SIP) Proxy Server;
 - a SIP Registrar and Location Server operable to store contact addresses of active mobile devices;
 - a PTT Server operable to function as a call endpoint for each of a plurality of mobile devices wherein the plurality of mobile devices are segmented into membership groups, the PTT Server further operable to multicast a communication from one member of the group to the other members of the group; and
 - an Internet Protocol (IP) network interconnecting the SIP Proxy server, the SIP Registrar and Location Server, and the PTT Server.
5. A method for user activation of push-to-talk (PTT) service in a wireless communication network, comprising:
 - initiating a session with a PTT Server wherein a user joins a group;
 - registering a contact for the user for media transmissions to other users in the group;

wherein the contact for the user is the PTT Server, the PTT Server functioning as an SIP call endpoint for the user.

15. A method for push-to-talk (PTT) group calls for users in a wireless communication network, comprising:
receiving a SIP SUBSCRIBE at a PTT Server from a mobile device to request the group's speech token;
transmitting an acknowledge message to the mobile device from the PTT Server wherein the acknowledge message includes a speech token;
receiving, by the PTT server, a half-duplex speech communication from the mobile device;
multicasting the half-duplex speech communication from the PTT Server to other members of a group, wherein the multicasting includes use of network address and port translation by the PTT server, whereby the PTT server replaces a destination IP address of a port number of received speech packets with an IP address of a port number of each target user and unicasts modified packets to each target user;
releasing the speech token; and
notifying the group members that the speech token is available.

26. A method for PTT private calls for users in a wireless communications network, comprising:
selecting a called party private identification for a private call by a calling party on a mobile device;
selecting a PTT function on the mobile device;
transmitting a SIP SUBSCRIBE including the calling and called parties private identifications to request a speech token;
redirecting the SIP SUBSCRIBE to a PTT Server for purposes of removing the calling party and the called party from a multicast group;
receiving an acknowledge message that includes a speech token;
communicating speech packets from the calling party to the called party in a half-duplex manner;
transmitting a SIP SUBSCRIBE to release the speech token; and

notifying the calling and called parties that the group's speech token is available.

Prior Art

The Examiner relies on the following prior art references to show unpatentability:

Maggenti	6,477,150 B1	Nov. 5, 2002
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Examiner's Rejections

1 The Examiner provisionally rejected claim 26 on the ground of nonstatutory obviousness type double patenting as unpatentable over claim 37 of copending application number 10/137, 551.¹

2. The Examiner rejected claims 5-16, 18, 19, 23, and 35 under 35 U.S.C. §102(e) as anticipated by Maggenti.

3. The Examiner rejected claims 1-4, 20-22, 24-34, and 36 under 35 U.S.C. §103(a) as unpatentable over Maggenti.

THE §102(e) REJECTION OVER MAGGENTI

Claims 5-16, 18, 19, 23 and 35

FINDINGS OF FACT

1. The Examiner found "an endpoint may comprise a transmitter or receiver, or an originating or terminating device in a network." (Ans. 19). Further, the Examiner found "[t]his is evidenced by the definition for

¹ The new obviousness type double patenting rejection set forth in the Answer is not before us because it is an improper new ground of rejection (*see* 37 C.F.R. §41.39(b)) and, in any event, the Examiner states that it is "not under review on appeal" (*see* Ans. 4).

'endpoint' in Newton's Telecom Dictionary (see def. for 'endpoint' on pg. 289)." (*Id.*).

The Maggenti Reference

We find the facts as follows:

2. The communication manager (CM) 218 of Maggenti functions as a switch. (Col. 2, ll. 30).
3. The CM communicates with communication devices (CD) (col. 8, ll. 11-13). For a calling device to participate in a net, the CD requests the CM to add it to a list of connected net participants (col. 10, ll. 46-48).
4. FIG. 4 illustrates CD 202 and CD 202 is a wireless telephone (col. 9, ll. 15-22; *see also* FIG. 4).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but by giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir.

1990)). The properly interpreted claim must then be compared with the prior art.

Claim 5

ISSUE

Have Appellants shown the Examiner erred in finding Maggenti teaches a Session Initiation Protocol (SIP) call endpoint?

ANALYSIS

Appellants contend "Maggenti fails to disclose at least registering a contact for a user 'for media transmissions to other users in the group' wherein the contact for the user 'is the PTT Server, the PTT Server functioning as an SIP call endpoint for the user' as recited in claim 5." (App. Br. 5).

Appellants argue (1) the portion of Maggenti cited by the Examiner (i.e., Maggenti, col. 10, lines 46-55), fails to teach or suggest the above "registering" limitation. (See App. Br. 5-6). Further, Appellants argue "the CM 218 functions as a switch ... rather than an endpoint." (*Id.* at 6).

The "examiner acknowledges that Maggenti teaches the CM 218 functioning as a switch, nevertheless, the examiner also maintains that this is only one of many functions provided by the CM." (Ans. 19). The Examiner also found it "was well known in the art at the time of the present invention [that] an endpoint may comprise a transmitter or receiver, or an originating or terminating device in a network." (*Id.*). Further, the Examiner found "[t]his is evidenced by the definition for 'endpoint' in Newton's Telecom Dictionary (see def. for 'endpoint' on pg. 289)." (*Id.*).

The Examiner "maintains the CM also functions as an endpoint since, when a user initiates a request to register with the CM to connect to net participants, the CM not only functions as a receiver in receiving the user request, the CM also functions as the terminating device for the user request since it is the CM that has to add the user 'to a list of connected net participants', (col. 10, lines 46-55)." (Ans. 19). Further, the Examiner found that (1) "when reading in light of appellant's specification, nothing teaches away from the interpretation examiner has given to appellant's claimed PTT server functioning as an SIP call endpoint, and (2) "[i]nstead, appellant's specification teaches the PTT server tracking active member participation in a group, and distributing received Real time Transport Protocol (RTP) voice packets to call participants, (see pg. 12, par. 0020)." (Ans. 19-20).

We agree with the Examiner. We find a CD is a user and that while the CM 218 may function as a switch, the CM 218 also functions as an endpoint, as the CM 218 serves as a receiver (i.e., endpoint) of a request sent from a user. (*See* FF 3).

Thus, Appellants have not persuaded us of error in the Examiner's conclusion of anticipation regarding claim 5. Accordingly, we affirm the Examiner's rejection of independent claim 5.

Claims 15 and 35

ISSUE

Have Appellants shown the Examiner erred in finding Maggenti teaches multicasting the half-duplex speech communication from the PTT

Server to other members of a group, wherein the multicasting includes use of a network address and port translation by the PTT server?

ANALYSIS

Appellants argue the CM 218 does not function as the SIP call endpoint for the user but instead merely functions as a switch (*see, e.g.,* Maggenti, column 2, lines 30-33); therefore, Maggenti does not need to provide network address and port translation. (App. Br. 6). As a result, Appellants argue, such features are not 'inherent' in the disclosure of Maggenti. (*Id.* at 7).

The Examiner also "maintains the CM taught by Maggenti indeed does function as an endpoint" (*id.* at 21).

We find, as discussed above with respect to claim 5, that Maggenti teaches the CM 218 functioning as an endpoint. Since Appellants base their argument on Maggenti not describing a SIP call endpoint, we find Appellants' argument that the "recited translation would not be necessary" because the CM 218 functions as a switch and not an endpoint is moot.

Accordingly, Appellants have not persuaded us of error in the Examiner's conclusion of anticipation regarding exemplary claim 15. Appellants argue independent claims 15 and 35 together. (*See* App. Br. 6-7). Therefore, we affirm the Examiner's rejection of claims 15 and 35.

Claims 6-14, 16, 18, 19, and 23

Appellants have not presented any new arguments with respect to claims 6-14 and claims 16, 18, 19, and 23 but instead rely on the arguments set forth for independent claims 5 and 15, respectively, from which they

depend. (App. Br. 7). Thus, for the reasons discussed above with respect to independent claims 5, 15, and 35, we affirm the rejections of (1) claims 6-14 which depend from independent claim 5, and (2) claims 16, 18, 19, and 23 which depend from independent claim 15.

THE §103(a) REJECTION OVER MAGGENTI

Claims 1-4, 20-22, 24,-34 and 36

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Claim 1

ISSUE

Have Appellants shown the Examiner erred in finding Maggenti teaches a call endpoint?

ANALYSIS

Appellants argue "none of the cited portions of Maggenti (i.e., column 4, line 49, through column 5, line 46; column 22, lines 45-58; and Figs. 2 and 8) teach, suggest, or render obvious the CM operating as 'a call endpoint' for each of a plurality of mobile devices, as described in the subject application and explicitly recited in claim 1." (App. Br. 8). Further, Appellants argue "[o]n the contrary, as described above with reference to claim 5, the CIM 218 is a configurable switch." (*Id.*).

The Examiner found the CM functions as an endpoint, as the Examiner found "the CM not only functions as a receiver in receiving the user request, the CM also functions as the terminating device for the user request since it is the CM that has to add the user 'to a list of connected net participants', (col. 10, lines 46-55)" (Ans. 19).

We agree with the Examiner. We conclude that one of ordinary skill in the art would recognize that a user making a request of the CM 218 is equivalent to the user calling upon the CM 218 to act. Moreover, as discussed above with respect to claim 5, we find that Maggenti teaches the CM 218 functioning as an endpoint for the user request (i.e., call). *See supra* p. 7.

Thus, Appellants have failed to convince us of error in the Examiner's finding of obviousness with respect to independent claim 1. Accordingly, we affirm the Examiner's rejection of claim 1.

Claims 26 and 36

ISSUE

Have Appellants shown the Examiner erred in finding the prior art teaches redirecting the SIP SUBSCRIBE to a PTT Server for purposes of removing the calling party and the called party from a multicast group?

ANALYSIS

Appellants argue "[t]he Examiner concedes that Maggenti fails to teach or suggest 'redirecting the SIP SUBSCRIBE to a PTT Server for purposes of removing the calling party and the called party from a multicast group.'" (*Id.*). Further, Appellants acknowledge "[t]he cited portion of Maggenti (column 20, lines 26-30) discloses that the CD 202 'may also support the concept of a "private call."'" (*Id.*).

However, Appellants argue (1) "the cited text contains no teaching or suggestion of how such a call may be implemented," and (2) "the Examiner has taken an impermissible leap to assume that, because Maggenti teaches operating over SIP protocol, that 'it would have been obvious' to implement a 'private call' in the manner recited in independent claim 26" (*id.*).

The Examiner "maintains such teachings, if not implicit, would be an obvious modification to the teachings of Maggenti, . . . as . . . Maggenti teaches the ability to redirect a request (i.e. SIP INVITE) to a PTT Server for purposes of joining or removing a calling party from a multicast group, (see col. 25, lines 12-15 and lines 51-57, also see col. 11, line 44-co1. 12, line 2)." (Ans. 23). Further, the Examiner found (1) "Maggenti also recognizes that a calling party must be removed from a multicast group in order to establish a private call, (see col. 14, lines 32-42, also see col. 20, lines 26-

30) and (2) at the time of the present invention, SIP SUBSCRIBE was a well known SIP method for a calling party to transmit a request to a server" (see pg. 3, section 2.1 and pg. 5, section 4.1.3)." (Ans. 23-24).

The Examiner concludes that

if not implicit in the teachings of Maggenti, one of ordinary skill would have found it obvious to modify the teaching of Maggenti, (i.e. by replacing the SIP INVITE request with the SIP SUBSCRIBE request) for the purpose of removing the calling party and the called part[y] from a multicast group to support a private call between a calling party and a called party, (Maggenti, col. 14, lines 32-42, also see col. 20, lines 26-30).

(*Id.* at 24).

We agree with Appellants. While the Examiner found "at the time of the present invention, SIP SUBSCRIBE was a well known SIP method for a calling party to transmit a request to a server," the Examiner fails to explain with particularity why it would be obvious to one of ordinary skill in the art to utilize SIP SUBSCRIBE to for purposes of "removing the calling party and the called party from a multicast group", as recited in claim 26.

Accordingly, Appellants have persuaded us of error in the Examiner's findings with regard to exemplary claim 26. Appellants argue claim 36 based on the arguments set forth for claim 26 and 36 together. (App. Br. 8). Claim 36 recites an analogous limitation and thus, for the reasons set forth for claim 26, we find Appellants have shown the Examiner erred. Accordingly, we reverse the Examiner's rejection of claims 26 and 36.

Dependent Claims 2-4, 20-22, 24, 25 and 27-34

The Examiner also rejected claims 2-4, 20-22, 24, 25 and 27-34 under 35 U.S.C. §103(a) as unpatentable over Maggenti. Appellants argue claims

2-4 are allowable over Maggenti for at least the reasons set forth with respect to claim 1. (App. Br. 9). Thus, for the reasons discussed above with respect to claim 1, we affirm the Examiner's rejection of claims 2-4.

Claims 20-22 depend from independent claim 15. Appellants do not separately argue claims 20-22 but instead rely on their arguments with respect to claim 15. Thus, for the reasons discussed above with respect to claim 15, we affirm the Examiner's rejection of claims 20-22.

Appellants argue "[c]laims 24-34 depend from and further limit independent claim 26 and are therefore also deemed to be in condition for allowance for at least the same reasons as claim 26." (App. Br. 9). We find claims 24 and 25 depend from independent claim 15 (App. Br. 13, Claims App'x) and Appellants have not presented additional arguments to show how the Examiner erred in rejecting these claims. Thus, for the reasons found above with respect to claim 15, we affirm the Examiner's rejection of claims 24 and 25.

However, we do find claims 27-34 depend on claim 26. Thus, for the reasons discussed above with respect to claim 26, we reverse the Examiner's rejection of claims 27-34.

CONCLUSION

Based on the findings of facts and the analysis above we conclude:

Appellants have not shown the Examiner erred in finding Maggenti teaches a Session Initiation Protocol (SIP) call endpoint. Further, Appellants have not shown the Examiner erred in finding Maggenti teaches multicasting the half-duplex speech communication from the PTT Server to other

members of a group, wherein the multicasting includes use of a network address and port translation by the PTT server.

Accordingly, Appellants have not shown that the Examiner erred in rejecting claims 5-16, 18, 19, 23, and 35 under 35 U.S.C. § 102(e) for anticipation by Maggenti.

Since claims 20-22, 24, and 25 depend from independent claim 15 and were not separately argued, we also find that Appellants have not shown the Examiner erred in rejecting claims 20-22, 24, and 25 under 35 U.S.C. § 103(a) for obviousness over Maggenti.

Further, Appellants have not shown that the Examiner erred in finding that Maggenti teaches a call endpoint. Accordingly, Appellants have not shown the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) for obviousness over Maggenti.

Since claims 2-4 depend from independent claim 1 and were not separately argued, we also find that Appellants have not shown the Examiner erred in rejecting claims 2-4 under 35 U.S.C. § 103(a) for obviousness over Maggenti.

Appellants have shown, however, that the Examiner erred in finding the prior art teaches redirecting the SIP SUBSCRIBE to a PTT Server for purposes of removing the calling party and the called party from a multicast group. Accordingly, Appellants have shown the Examiner erred in rejecting claims 26-34, and 36 under 35 U.S.C. § 103(a) for obviousness over Maggenti.

DECISION

We affirm the Examiner's rejection of claims 5-16, 18, 19, 23, and 35 under 35 U.S.C. §102(e) over Maggenti.

We affirm the Examiner's rejection of claims 1-4, 20-22, 24 and 25 under 35 U.S.C. § 103(a) over Maggenti.

We reverse the Examiner's rejection of claims 26-34, and 36 under 35 U.S.C. § 103(a) over Maggenti.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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